

Appl. No. 10/010,391
Atty. Docket No. 8384R
Amdt. dated Feb. 26, 2004
Reply to Office Action of Nov. 26, 2003
Customer No. 27752

REMARKS

Claims 1, 2, 5-8, 11, 13-16, and 18 are pending in the present application. No additional claim fee is believed to be due.

Claims 10, 12, 17, 19, and 20 are cancelled without prejudice.

Claims 1, 11, and 15 have been amended to more specifically characterize the gathering and the separating of the tubular sheet from the trailing edge of the tubular sheet. Support for this amendment is found at page 8 – 9, lines 18-8, and Figures 4 and 5 of the specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Double Patenting

The Office Action has rejected the claimed invention under the judicially created doctrine of obviousness type double patenting. The Office Action asserts that claims 1, 2, 5-8, 11, 13-16, and 18 are unpatentable over claims 1, 3, and 6-10 of copending application no. 09/745,702. Applicants have filed a terminal disclaimer in order to overcome this rejection. Also, the Applicants assert that the currently pending application, Application No. 10/010,391 and Application No. 09/745,702, were owned by the Procter and Gamble Corporation at the time the invention of the currently pending application was made.

Rejection Under 35 USC 103(a) Over Lecomte in view of Hamilton et al.

Claims 1, 2, 5-8, 11, 13-16, 18 and 20, have been rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,065,272 issued to Lecomte in view of U.S. Patent No. 5,662,758 issued to Hamilton et al. In order to establish a prima facie case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.* Applicants respectfully traverse the rejection by the Office Action because the cited combination fails to teach or suggest all of the claim limitations, and there is no motivation to combine the cited references.

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First, the cited combination fails to teach or suggest all of the claim limitations of the claimed invention. Amended claims 1, 11, and 15 recite, *inter alia*, "wherein the casing or the storage space comprises a slot for gathering and separating a packaged article from a trailing portion of the tubular sheet as the tubular sheet is inserted and moved through the slot." The Lecomte reference teaches a pair of welding pliers as the primary mode for sealing the sleeve and thereby gathering the sleeve. (See col. 4, lines 25-30, lines 36-40, lines 42-45, and lines 52-55). When the pair of welding pliers is omitted, the Lecomte reference teaches that "the constant pressure of the rollers on the sleeve allows an already consequent confinement." (col. 4, lines 55-59). Thus, the Lecomte reference teaches that the gathering and separating a packaged article from the sleeve is performed either via pliers or rollers but does not teach or suggest gathering of the sleeve via a slot.

The Hamilton reference teaches the method of making a three dimensional film having adhesive thereon. However, the Hamilton reference fails to teach or suggest a slot for gathering a tubular sheet. Thus, neither the Lecomte nor the Hamilton reference teach or suggest a slot which gathers a tubular sheet as the sheet is inserted therein as recited in amended claims 1, 11, and 15.

Second, there is no motivation to combine the cited references. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." See *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966). The Lecomte reference teaches a pair of welding pliers as the primary mode for sealing the sleeve. (See col. 4, lines 25-30, lines 36-40, lines 42-45, and lines 52-55). Because the Lecomte reference teaches that an adequate seal is created via the welding process or in the absence of the welding process, via the constant pressure of the rollers, one skilled in the art would be led in "a direction divergent from the path that was taken by the" Applicants. Specifically, one skilled in the art would not think about whether an adhesive should be added to the sleeve because even in the absence of its primary sealing mechanism, the constant pressure of the rollers creates "an already consequent confinement." (*Id.*) Thus, the Lecomte reference teaches away from any suggested combination with Hamilton et al. and therefore, there is no motivation or suggestion to combine the cited references.

The MPEP section 2143.01 states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*citing* In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). In the Mills case, the claimed invention was directed toward an apparatus for producing

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an aerated cementitious composition. *In re Mills*, 916 F.2d at 681. The composition was created by driving air into an output pump at a rate that was greater than the feed rate of the pump. *Id.* The cited prior art reference taught that the speed of the prime mover could be controlled by a variable speed transmission. *Id.* at 682. The court found that the teachings of the prior art reference were inadequate to establish a *prima facie* case of obviousness because the cited reference did not require the output pump to run at the claimed speed. *See Id.*

Similar to the Mills case cited above, the Lecomte reference teaches a device for packaging articles in a sleeve, wherein the article is driven into the sleeve by rollers, and **tight closure of the sleeve is effected as desired.** (emphasis added)(col. 2, lines 5-10). However, the Lecomte reference while stating that tight closure of the sleeve may be effected as desired, does not require that the sleeve comprise an adhesive to accomplish the sealing of the sleeve nor does it make any mention of creating a better seal via a different process. Because the Lecomte reference makes no recommendation or suggestion on how to improve the sealing of the sleeve, the Lecomte reference does not provide any suggestion or motivation to make the cited combination with the Hamilton et al. reference.

Because the cited combination of references fails to teach or suggest all of the claim limitations of amended claims 1, 11, and 15, and because there is no motivation to combine the cited references, the Office Action has failed to establish a *prima facie* case of obviousness. Therefore, Applicants assert that amended claims 1, 11, and 15 are non-obvious over the cited combination and are in condition for allowance. In addition, because claims 2 and 5-8 depend from claim 1, claims 13-14 depend from claim 11, and claims 16-18 depend from claim 15, Applicants assert that these claims are also non-obvious over the cited combination and are therefore in condition for allowance.

Rejection Under 35 U.S.C. 103(a) Over Richards et al. in view of Hamilton et al.

Claims 1, 2, 5-8, 11, 13-16, 18 and 20, have been rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 4,869,049 issued to Richards et al. in view of U.S. Patent No. 5,662,758 issued to Hamilton et al. Applicants respectfully traverse the rejection by the Office Action because the cited combination fails to teach or suggest all of the claim limitations of the claimed invention, and there is no motivation to combine the cited references.

First, the cited combination fails to teach or suggest all of the claim limitations of the claimed invention. Amended claims 1, 11, and 15 recite, *inter alia*, "wherein the casing or the

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storage space comprises a slot for gathering and separating a packaged article from a trailing portion of the tubular sheet as the tubular sheet is inserted and moved through the slot.”

In contrast, the Richards et al. reference teaches a packaging device which utilizes pleated tubing to package articles. (Abstract). The Richards et al. reference teaches that the top of the pleated tubing is pulled upward and tied into a knot thereby forming the bottom of the package. (col. 3, lines 11-14). Next, after the articles are placed within the tubing, the tubing is twisted such that a seal is formed. (col. 3, lines 55-60). Therefore, the tubing is gathered via the twisting motion of the device as opposed to a slot.

As mentioned previously, the Hamilton et al. reference teaches the method of making a three dimensional film with adhesive thereon. However, the Hamilton et al. reference also fails to teach or suggest “a slot for gathering and separating a packaged article from a trailing portion of the tubular sheet as the tubular sheet is inserted and moved through the slot.” Thus, the cited combination of references fails to teach or suggest all of the claim limitations of the claimed invention.

Second, there is no motivation to combine the cited references. The Richards et al. reference teaches several methods for sealing the pleated tubing. The Richards et al. reference teaches that even if the intermediate twisted seals become loose, the topmost twisted seal prevents odors from escaping. (col. 3, lines 54-60). The Richards et al. reference recommends the use of high density polyethylene because joints that are created using this material remain tight. *Id.*

In contrast, the Hamilton et al. reference teaches a three dimensional film having adhesive thereon. Because one skilled in the art would be inclined to use the sealing methods taught in the Richards et al. reference rather than using the three dimensional film of the Hamilton et al. reference, the Richards et al. reference teaches away from the use of the film of the Hamilton et al. reference. Because the Richards et al. reference teaches away from using the film of the Hamilton et al. reference, there is no motivation to combine the cited references.

Because the cited combination of references fails to teach or suggest all of the claim limitations of the claimed invention and because there is no suggestion or motivation to combine the cited references, the Office Action has not established a *prima facie* case of obviousness. Therefore, Applicants assert that claims 1, 11, and 15 are non-obvious over the cited combination and are in condition for allowance. In addition, because claims 2 and 5-8 depend from claim 1, claims 13-14 depend from claim 11, and claims 16-18 depend from claim 15, Applicants assert

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that these claims are also non-obvious over the cited combination and are therefore in condition for allowance.

Office Action's Response to Previous Arguments by Applicants

The Office Action asserts that the tubular sheet is a work piece being used with the apparatus and is therefore not considered as a structure limitation of the claim. Applicants respectfully traverse this assertion. Section 2115 of the MPEP provides that the line of cases which discuss work articles only applies to "machinery which works upon an article or material in its intended use." During its intended use, the claimed packaging device packages an article. Therefore, the claimed packaging device does not work on the length of flexible tubular sheet but rather works on the article to be packaged.

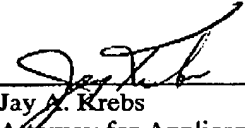
Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1, 2, 5-8, 11, 13-16, and 18.

Respectfully submitted,
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